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EXAMINER

PIERCE, WILLIAM M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEVIN PARSONS

Appeal 2015-003456
Application 13/955,697
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and LEE L. STEPINA,
Administrative Patent Judges.

STEPINA, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Kevin Parsons (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

CLAIMED SUBJECT MATTER

The claims are directed to an apparatus with a button having a marginal end coincident with an outside edge of an outer most tube. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An apparatus comprising:

a plurality of coaxially nesting tubes, each having a first end and a second end with a recess on an inside surface of some of the second ends, the plurality of tubes having a stowed position where the first ends are adjacent and an extended position where the first end of an inside tube is directly adjacent the second end of the next adjacent outside tube;

a respective spring-loaded retainer located on a first end of each of at least one of the plurality of nesting tubes, each respective retainer having an outer edge coupled to a control aperture wherein the control aperture operates to retain the outer edge coincident with an outside annular edge of the at least one tube in a retracted position and wherein a spring of the retainer urges the outer edge radially outwards into the recess of the second end of the next adjacent outside tube; and

a control rod having a button on one end and a tapered tip on the opposing end, the control rod is located inside and is coaxial with the coaxially nesting tubes with a marginal end of the control rod and button coincident with an outside marginal annular edge on the first end of an outer most of the plurality of tubes, the control rod engages the control aperture of each of the at least one of the plurality of nesting tubes in the stowed position to retain the outer edge of the respective retainers in a retracted position and as the plurality of tubes are extended, the tapered end of the control rod disengages the control aperture thereby causing the button to abruptly pop outwards from the marginal edge of the outer most tube.

REFERENCE

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Pelkey

US 2013/0150167 A1 June 13, 2013

REJECTIONS¹

(I) Claims 2 and 3² are rejected under 35 U.S.C. § 112(b) as indefinite.

(II) Claims 1–20 are rejected under 35 U.S.C. § 102(a)(2) as anticipated by Pelkey.

OPINION

Rejection (I)

The Examiner states that the term “spring loaded” in claim 2 “should be hyphenated for consistency.” Final Act. 3. The Examiner finds that the term “semicircular plate” in claim 2 is not consistent with the Specification, because the Specification uses the term “**semicircular locking pegs**” to describe the locking element of the retainer. *Id.* (citing Spec. ¶ 21).

Appellant makes no arguments traversing the Examiner’s rejection of claim 2 as indefinite. *See* Appeal Br. 9–10. Accordingly, we summarily sustain this rejection.

¹ A rejection of claims 1–20 under 35 U.S.C. § 101 as claiming the same invention as that of claims 1–20 of copending Application No. 13/955,842 is withdrawn in the Answer. Ans. 2 (mailed Nov. 28, 2014). A provisional rejection of claims 1–20 on the ground of nonstatutory obviousness-type double patenting over copending Application No. 14/078,889 is withdrawn in the Answer. *Id.* at 2–3.

² The rejection under 35 U.S.C. § 112, originally included each of claims 1–20. Final Act. 3 (mailed Sept. 4, 2014). The rejection remains as to claims 2 and 3, as the rejection of claims 1 and 14 has been withdrawn by the Examiner. Ans. 3. Claim 3 appears to be rejected based on its dependence from claim 2. However, the Examiner has not addressed claims 4 and 5, which also depend from claim 2.

Rejection (II)

Claim 1 recites, in part, “as the plurality of tubes are extended, the tapered end of the control rod disengages the control aperture thereby causing the button to abruptly pop outwards from the marginal edge of the outer most tube.” Independent claims 7 and 14 include substantially similar limitations.

The Examiner finds that the recited limitations of nesting tubes, spring loaded retainer, and control rod are “clearly anticipated.” Final Act. 4. The Examiner considers that the button abruptly popping outwards is a functional limitation that is inherent. *Id.*

Appellant argues that the Examiner’s reliance on inherency is improper, because “there is no extrinsic evidence that makes clear that ... ‘the tapered end of the control rod disengages the control aperture thereby causing the button to abruptly pop outwards from the marginal edge of the outer most tube’ is necessarily present in Pelkey.” Appeal Br. 12.

The Examiner responds that “the standard is that Pelkey must be incapable of performing the functions recited.” Ans. 6 (citing *Ex parte Justis & Molz IV*, No. 2010-001025, 2011 WL 3791632, at *1 (B.P.A.I. Aug. 22, 2011). The Examiner states that because “button 9 of Pelkey can be depressed inwardly while the tubes are expanded and the button release(d) to ‘abruptly pop outwards,’ such function does not clearly distinguish over it and Appellant’s remarks are not persuasive.” *Id.*

Appellant replies that “it is not necessary that it be impossible for a reference to perform in a particular way.” Reply Br. 3. Appellant asserts that rather, “a person of skill in the art would understand that it would not

operate in that particular way and this is clearly the case in Pelkey because there is no disclosure in Pelkey of a control “button ... abruptly pop [sic] outwards from the marginal edge of the outermost tube.” *Id.*

We agree with Appellant on this point. Claim 1 requires that the tapered end of the rod disengages the control aperture, and this causes the control button to abruptly pop outwards. That is, the claimed apparatus has structure that causes control button 24 to move outwards, i.e., abruptly pop outwards, because the control rod is no longer in contact with a control aperture. Consistent with this interpretation, the Specification discloses that the tubes are extended so that the control rod exits apertures 36a, 36b of retainer 28, and then is further extended so that the control rod exits the apertures 36a, 36b of retainer 26. Spec. ¶¶ 24–25. The Specification further discloses that “as the control rod exits the retainer 26, a control rod spring 52 (FIG. 2) pushes the button outwards at the same instant as the baton locks in the fully deployed state.” Spec. ¶ 26.

Pelkey does not disclose structure that functions in this manner. Figure 3 of Pelkey shows clutch alignment rod 12 released from clutch 14 (retainer), and still in engagement with clutch 16 (retainer), but with button 9 in an outward position. Pelkey, Fig. 3. Thus, when rod 12 of Pelkey is still in contact with apertures 23 of retainer 16, button 9 has already moved outward. In Pelkey, “[t]he spring forces the release button to project outwardly from the rear cap.” Pelkey ¶ 34. As such, spring 11 of Pelkey appears to force the release button to project outwardly *at all times* unless a user pushes the button inwardly, and the Examiner does not point to factual evidence, or provide sound technical reasoning to the contrary. Although we

appreciate that the button of Pelkey could be pushed in by a user and then released to simulate popping out, the claim requires structure that causes this function, not a user's finger.

Accordingly, we do not sustain the Examiner's rejection of claims 1–20 as anticipated by Pelkey.

DECISION

We affirm the rejection of claims 2 and 3 under 35 U.S.C. § 112(b) as indefinite.

We reverse the rejection of claims 1–20 under 35 U.S.C. § 102(a)(2) as anticipated by Pelkey.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART